



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/676,424

10/01/2003

Edvard Falt

9000/2023

1506

29933 7590 07/26/2007

PALMER & DODGE, LLP
KATHLEEN M. WILLIAMS
111 HUNTINGTON AVENUE
BOSTON, MA 02199

EXAMINER

AGRAWAL, RITESH

ART UNIT

PAPER NUMBER

1631

MAIL DATE

DELIVERY MODE

07/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/676,424	Applicant(s) FALT ET AL.	
	Examiner Ritesh Agrawal	Art Unit 1631	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 03 July 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: None.
 Claim(s) objected to: None.
 Claim(s) rejected: 1-6,9-12,15-17,21-26,30-33 and 35.
 Claim(s) withdrawn from consideration: 7,8,13,14,18-20,27,28 and 34.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.


 JOHN S. BRUSCA, PH.D.
 PRIMARY EXAMINER

Continuation of 3. NOTE: Applicants amended claim set adds new limitations of identifying traits of a specimen prior to the administration of a test agent and identifying a difference between traits before and after administration of test agents. The newly amended claim set will therefore require additional search and/or consideration because the pending claim set did not require these limitations. For example, the pending claim set only required a much broader step of "correlating" traits of a specimen with effects of a test agent after administration of the test agent whereas the amended claim set specifically requires determining a difference in traits before and after treatment with an agent.

Continuation of 11. does NOT place the application in condition for allowance because: The pending claim set will still be rejected and the amended claim set has not been entered for the reasons outlined above.

The claims will still be rejected over the indefiniteness of the timing of the digital image (before or after administering the test agent). Applicants' arguments against the rejection (remarks, page 10, bottom paragraph through page 11, 1st paragraph) rely on the entry of the amended claim set. As the amended claim set has not been entered, applicants' arguments are not relevant to the pending claim set.

Furthermore, the indefiniteness rejection over the limitation of the placement of the step of "quantifying" traits as in claims 3-4 will be maintained over the present claim set. Applicants' arguments rely on the amended claim set being entered (page 11, 2nd-3rd paragraph). Since the amended claims have not been entered, applicants' arguments are not relevant to the pending claim set.

The indefiniteness rejection over the use of the phrase "more or less similar" in claims 10 and 15 will still be maintained. Applicants arguments that the limitation is clear upon reading the claims in light of the specification (pg. 13, 2nd paragraph) is not found persuasive. While claims are read in light of the specification, it is inappropriate to read limitations into the claims based upon the specification. In common language, the phrase "more or less" can either represent a dichotomous relationship, or one that is interpreted as "approximately". As the specification does not clearly limit the phrase to either interpretation, the limitation can be interpreted either way and is therefore indefinite.

Furthermore, the rejection of the claims under 35 U.S.C. 102(e) will be maintained. Applicants' argument that Botas does not teach creating a digital image showing effects of a test on a trait (remarks, page 14, 1st paragraph) is not found persuasive. Botas discloses several digital images (for example, figures 1-7) of showing traits of *Drosophila* in the presence of misexpression tests of various genes.

RA